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REMARKS

This response is intended as a full and complete response to the final Office Action mailed April 7, 2005.

Claims 1-3, 5, 7-12 are pending. Claims 1, 3, 5, 7, and 8 are amended. Claims 9-12 are added. The amendments contain no new matter and are fully supported by the Applicants' original specification, including the drawings and the original claims.

In view of the above amendments and the following discussion, the Applicants respectfully submit that the claims are nonobvious over the cited references under 35 U.S.C. §103. Thus, the Applicants believe that the application is in condition for allowance.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the amendments.

Claims Patentable under 35 U.S.C. §103

Claims 1, 3, 5 and 7

The Office Action rejected claims 1, 3, 5 and 7 as being unpatentable over U.S. Patent No. 5,973,682 to Saib et al. ("Saib") in view of U.S. Patent No. 5,422,674 to Hooper et al. ("Hooper").

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or nonobvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

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A *prima facie* case of obviousness requires that the combination of references must teach or suggest all the claim elements. The Office Action has failed to establish a *prima facie* case of obviousness.

The Applicants respectfully traverse the rejection, because the combination of Saib and Hooper fails to teach or suggest all the claim elements. For example the combination of Saib and Hooper fail to teach or suggest overlaying a channel information window over a broadcast video presentation, which is programming from a channel (not a still image), so that the channel information window obscures at least a portion of the broadcast video presentation.

Claim 1 recites, *inter alia*, "transmitting a broadcast video presentation from a server to a terminal, the broadcast video presentation being programming from one of a plurality of channels" and "overlaying the bitmap for the channel information window over the broadcast video presentation on a display associated with the terminal so that the channel information window obscures at least a portion of the broadcast video presentation".

Saib fails to teach or suggest overlaying the channel information window over the broadcast video presentation. By contrast, Saib teaches away from any overlaid channel information window by disclosing a screen 720 containing program broadcast 710 and a display information packet 702 in completely separate and non-overlapping sections of an electronic program guide (EPG). (Saib, figure 7, col. 6, lines 33-35). Saib teaches away because it is more directed towards textured and non-textured patterns of the EPG. (Saib, title, abstract). Saib teaches away by disclosing replacing display information packet of first program with display information packet of second program broadcast in response to movement of the system pointer to an area of the EPG associated with the second program broadcast. (Saib, figure 8). Saib teaches away by disclosing that a display information packet is displayed along with (not overlaid) the electronic program guide. (Saib, col. 7, lines 11-12). Because Saib teaches away, Saib does not suggest overlaying the channel information window over the broadcast video presentation.

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Hooper fails to teach or suggest overlaying a broadcast video presentation that is programming from a channel. By contrast, Hooper discloses a background image that is a still image being overlaid. (Hooper, col. 2, lines 61-65, col. 6, line 11-14). Clearly, a still image is different from the claimed broadcast video presentation that is programming from a channel. Furthermore, the fact that Hooper resorts to having a special dedicated channel to deliver a still image background teaches away from broadcast video, which was already available. (Hooper, col. 2, lines 21-25). Hooper teaches away by creating frames that refer to a complete still image to be displayed, the background image 30 of figure 1. (Hooper, col. 6, lines 44-46). Because Hooper teaches away, Hooper does not suggest the claimed overlying of a broadcast video presentation that is programming from a channel.

As a result, the combination of Saib and Hooper fails to teach or suggest the claim elements as recited in claim 1. Therefore, claim 1 is patentable over the combination of Saib and Hooper under 35 U.S.C. §103.

Claims 2 and 3 depend, directly or indirectly, from claim 1 and, thus, inherit the patentable subject matter of claim 1, while adding more elements. Therefore, claims 2 and 3 are also patentable over the combination of Saib and Hooper under 35 U.S.C. §103.

Claim 5 recites, inter alia, "transmitting a plurality of broadcast video displays on a plurality of channels from a server to a terminal, the broadcast video displays including a particular broadcast video display, each broadcast video display being programming from one of the channels" and "overlaying the channel information window on a the particular broadcast video display on a display so that the channel information window obscures at least a portion of the broadcast video display". For the same reasons given above with respect to claim 1, claim 5 is also patentable over the combination of Saib and Hooper under 35 U.S.C. §103.

Claims 7 and 8 depend, directly or indirectly, from claim 5 and, thus, inherit the patentable subject matter of claim 5, while adding more elements. Therefore, claims 7 and 8 are also patentable over the combination of Saib and Hooper under 35 U.S.C. §103.

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Claims 9-12 recite similar subject matter and, for the same reasons given above with respect to claim 1, claims 9-12 are also patentable over the combination of Saib and Hooper under 35 U.S.C. §103.

Therefore, the Applicants respectfully request that the rejection of claims 1, 3, 5 and 7 be withdrawn and new claims 9-12 be allowed.

Claim 2

The Office Action rejected claim 2 under 35 U.S.C. §103(a) as being unpatentable over Saib and Hooper as applied to claim 1 above, and further in view of U.S. Patent No. 5,247,364 to Banker et al. ("Banker").

The Applicants respectfully traverse the rejection, because the combination of Saib, Hooper, and Banker fails to teach or suggest all the elements of claim 2. For the reasons given above with respect to claim 1 and because Banker also fails to teach or suggest overlaying a channel information window over a broadcast video presentation, which is programming from a channel.

Therefore, the Applicants respectfully request that the rejection of claim 2 be withdrawn and that claim 2 be passed to allowance.

Claim 8

The Office Action rejected claim 8 as being unpatentable under 35 U.S.C. §103(a) as being unpatentable over Saib and Hooper as applied to claim 5 above, and further in view of U.S. Patent No. 5,619,249 to Billock et al. ("Billock").

The Applicants respectfully traverse the rejection, because the combination of Saib, Hooper, and Billock fails to teach or suggest all the elements of claim 8. For the reasons given above with respect to claim 1 and because Billock also fails to teach or suggest overlaying a channel information window over a broadcast video presentation, which is programming from a channel.

Therefore, the Applicants respectfully request that the rejection of claim 8 be withdrawn and that claim 8 be passed to allowance.

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CONCLUSION

In view of the foregoing, the Applicants respectfully submit that the claims presently in this application are nonobvious over the cited references under 35 U.S.C. §103. The Applicants believe that this application is in condition for allowance. Reconsideration of this application and its swift passage to issue are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

6/7/05

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